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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,246	12/03/1998	DOLORES LUDEVID	50062/004001	3466
21559	7590	03/23/2005	EXAMINER	
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			KALLIS, RUSSELL	
			ART UNIT	PAPER NUMBER
			1638	
DATE MAILED: 03/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/117,246	Applicant(s) LUDEVID ET AL.	
	Examiner Russell Kallis	Art Unit 1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): new matter and 112 2nd.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 98.
- Claim(s) objected to: _____.
- Claim(s) rejected: 42,43,45,46,84-97 and 99-110.
- Claim(s) withdrawn from consideration: 51,56,65-68 and 76.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: Claim 89 which recites "plant protein" is broader in scope than canceled claim 47 which recited "plant protein reserve" raises issues of new matter and would require further search and consideration.

Claim 107 is drawn to a maize gamma plant which raises issues of new matter and would also require further consideration and search.

The rejection under 35 USC 112 1st paragraph, written description, that the specification does not adequately describe a representative number of plant protein reserve or maize gamma zein is maintained for reasons of record. Applicant's arguments that the present claims are limited to proteins (i.e. a plant protein) and constructs (polynucleotides) taught in the specification is not persuasive because the claims are drawn to modified proteins not described in the specification (see Claim 89). While Applicant need not explicitly describe each and every species of a claimed genus to meet the written description requirement Applicant must provide a representative number of species within the genus to allow one of skill in the art to reliably predict the structure of other species within the genus. In Applicant's disclosure, Applicant has disclosed only constructs comprising polynucleotides encoding modified maize gamma zein of 28kDa of P20-gamma-zein, H30-gamma-zein and H45-gamma-zein is not deemed adequate to encompass the genus of all plant proteins reserve or otherwise.

The rejection under 35 USC 112 1st paragraph, lack of enablement, that the claimed invention is enabled for maize transformed with a polynucleotide of SEQ ID NO: 6, 8 or 10 that comprises a modified maize gamma zein of 28kDa. Applicant's argument that the modified protein of Claim 89 is a gamma zein is not commensurate in scope with the claims as the claims are not limited to a modified maize gamma zein of 28kDa. The claim is broadly drawn to a plant protein recited in line 2 Claim 89 that has no structural link to the maize gamma zein of 28kDa recited in the last line of the claim.

The rejection under 35 U.S.C. 102 is maintained for reasons of record. The amendment to Claim 42 and new added claim 84 raises new issues that would require further consideration and search. The amended claim recites 'the sequence' yet there is no antecedent basis for this in the claim and it is therefore unclear whether 'the sequence of n (P-K) units that is interrupted' refers to the n (P-K) unit itself or to concatenations of said unit (i.e. repetitions). Further, the claim states unequivocally that the oligonucleotide comprises at least one concatenation that codes for a polypeptide with the formula of n (P-K), and then follows with a limitation that states that the oligonucleotide does not follow the formula of n (P-K) but that it is something else also raises new issues under written description. Moreover, if one were to have either the n (P-K) unit itself interrupted or the multiple instances of said unit (concatenations) interrupted, then dependent claims 43, 45 and 46 selectively affirm the latter and as such claims 42-43 and 45-46 remain rejected under 102(b). In addition it is not clear if the P-K unit is interrupted (i.e. P-x-K) or if P-K units are interrupted (i.e. P-K-x-P-K) or a combination thereof, and as such further search and consideration would be required.



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